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JUL 10 2002

GROUP 1600

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## FACSIMILE TRANSMISSION COVER SHEET

Date: July 9, 2002  
Time: 5:35 PM  
From: Thomas T. Aquilla  
To: Examiner Pappu, TC 1636  
Re: 10/043,366  
Facsimile #: 703-872-9306

OFFICIAL

Number of Pages (including this cover sheet): 4

Faxed with this cover sheet is the following:

RESPONSE TO RESTRICTION REQUIREMENT FOR 10/043,366

## CERTIFICATE OF FACSIMILE TRANSMISSION

FACSIMILE NO: 703-872-9306

DATE: 7/9/2002

I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, to the facsimile number and on the date indicated above.

  
Thomas T. Aquilla

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During a telephone interview, Applicant's attorney told the Examiner that Group I would be elected for further prosecution, with a traverse of the restriction requirement.

The election of Group I and the species defined by claims 1-40 and 43 is hereby confirmed. The requirement for restriction, as best understood, is respectfully traversed.

The MPEP states the following with regard to stating a *prima facie* case of restriction between patentably distinct inventions:

"There are two criteria for a proper requirement for restriction between patentably distinct inventions:

1) The inventions must be independent (see MPEP 802.01, 806.04, 808.01) **or distinct as claimed** (see MPEP 806.05-806.05(i)); and

2) There must be a **serious burden on the examiner** if restriction is not required (see MPEP 803.02, 806.04(a) - 806.04(j), 808.01(a) and 808.02).

### **GUIDELINES**

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases. **Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.** For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02 and MPEP 803.

All of the claims recite related inventions in that each recites an experimental animal. The Examiner did not make a *prima facie* case to support a restriction requirement. Both criteria for restriction must be established and the Examiner has not alleged neither much less shown any burden or distinctiveness in the claimed inventions. The Examiner merely states that the applicant provided multiple examples of the invention. This does not mean that there are "distinct" inventions as defined in the MPEP. Furthermore, distinct inventions do not create a

burden on the Examiner that is sufficient to justify a restriction requirement without a showing of the need for separate searches.

All of the inventions could be searched within the same classes and subclasses. Even if some of the inventions would be classified separately, a thorough search of the prior art for any one of the inventions would include the classes and subclasses of the other inventions.

The Applicant requests that the restriction requirement be withdrawn. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, she is invited to telephone the undersigned at the number given below.

#### Conclusion

Applicant believes the claims are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

--Iwao Katsuyama--

By: \_\_\_\_\_  
Thomas T. Aquilla, 43,473  
Attorney for Applicant

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Dated: July 9, 2002

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GROUP 1600

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

July 9, 2002

In re Application of: Katsuyama  
Serial No. 10/043,366  
Filed: 01/10/2002  
For: EXPERIMENTAL ANIMALS FOR EVALUATION OF  
THERAPEUTIC EFFECTS ON CORNEAL EPITHELIAL  
DAMAGES  
Examiner: Pappu, Sita S.  
Art Unit: 1636  
Confirmation Number: 6348  
Attorney Docket No.: KUP-D0135

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## REPLY TO OFFICE ACTION

HONORABLE COMMISSIONER OF  
PATENTS AND TRADEMARKS  
Washington, D.C. 20231

## REMARKS

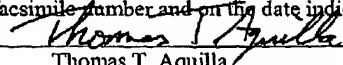
The Office Action of June 15, 2002 has been reviewed and its contents carefully noted.  
Reconsideration of this case is earnestly requested. Claims 1-43 remain in this case.

## Restriction Requirement

The Examiner has made a restriction requirement and has identified two inventions, as follows:

Group I: claims 1-40 and 43, drawn to an experimental animal, classified in class 800, subclass 9.

Group II: claims 41 and 42, drawn to a medicine, classified in class 424, subclass 9.1.

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 Thomas T. Aquila	

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